Supreme Court, U.S.
FILED

981519 MAR 22 1999

OFFICE OF THE CLERK

No.

IN THE

Supreme Court of the United States

OCTOBER TERM, 1998

WEST PUBLISHING CO. and
WEST PUBLISHING CORPORATION,

Petitioners,

v.

HYPERLAW, INC.,

Respondent.

ON PETITION FOR WRIT OF CERTIORARI
TO THE UNITED STATES COURT OF APPEALS
FOR THE SECOND CIRCUIT

PETITION FOR WRIT OF CERTIORARI

JAMES F. RITTINGER
Counsel of Record
JOSHUA M. RUBINS
SATTERLEE STEPHENS BURKE
& BURKE LLP
230 Park Avenue
New York, New York 10169
(212) 818-9200

ARTHUR R. MILLER
228 Areeda Hall
1545 Massachusetts Avenue
Cambridge, Massachusetts 02138
(617) 495-4111

Attorneys for Petitioners

104P

QUESTIONS PRESENTED

1. Does an author of a compilation or a derivative work fail to meet the standard for originality set forth in *Feist Publications, Inc. v. Rural Telephone Service Co.*, 499 U.S. 340, 111 S. Ct. 1282 (1991), if the author's contributions are non-trivial and reflect numerous editorial judgments in choosing, from among several possibilities, which facts to select and/or how to arrange the included facts?

2. Does the Copyright Act require that the author of a textual derivative work, based on a pre-existing public domain work, make changes that substantially alter the "substance and flow" of the underlying work?

3. Does a plaintiff, seeking a declaratory judgment denying copyright protection to tens of thousands of different derivative works, meet its burden of proof if it offers into evidence only a statistically insignificant, non-representative sampling of those works?

4. What is the proper standard of review when an appellate court reviews a finding of copyright originality based on undisputed facts?

PARTIES TO THE PROCEEDING

The parties before this Court are those set forth in the caption. Pursuant to Rule 29.6, we advise the Court that West Publishing Company and West Publishing Corporation are wholly owned indirect subsidiaries of The Thomson Corporation, whose shares are publicly traded in Canada and the United Kingdom but not in the United States. West Publishing Company, West Publishing Corporation, and The Thomson Corporation do not have any subsidiaries that are publicly traded.

TABLE OF CONTENTS

	Page
Questions Presented	i
Parties to the Proceeding	ii
Table of Cited Authorities	v
Opinions Below	1
Statement of Jurisdiction	1
Constitutional and Statutory Provisions Involved	1
Statement of the Case	4
A. The Editorial Enhancements at Issue	6
B. The District Court's Decision	10
C. The Court of Appeals' Decision	11
Reasons for Granting the Writ	11
I. The Petition Should Be Granted Because The Second Circuit Has Erected Unprecedented Barriers To Copyright Protection That Conflict With The *Feist* Standard	11
II. The Petition Should Be Granted Because Judicial Confusion Regarding *Feist* Has Led To Inconsistent Treatment Of, And Underprotection For, Compilations And Derivative Works	15

Contents

Page

III. The Petition Should Be Granted Because Confusion Concerning The Originality Standard For Derivative Works Poses A Serious Disincentive To The Creation Of New Works 23

IV. The Petition Should Be Granted Because The Second Circuit Departed From Longstanding Principles As To The Burden Of Proof In Declaratory Judgment Actions 27

V. The Petition Should Be Granted So That This Court Can Address Judicial Division As To The Proper Standard Of Review In Cases Involving Copyright Originality 27

Conclusion 29

TABLE OF CITED AUTHORITIES

Page

Cases:

Alfred Bell & Co. v. Catalda Fine Arts, Inc., 191 F.2d 99 (2d Cir. 1951) 24, 25

Atari Games Corp. v. Nintendo of Am., Inc., 975 F.2d 832 (Fed. Cir. 1992) 19

Atari Games Corp. v. Oman, 979 F.2d 242 (D.C. Cir. 1992) 19, 20

BellSouth Advertising & Publishing Corp. v. Donnelley Information Publishing, Inc., 999 F.2d 1436 (11th Cir. 1993), *cert. denied*, 510 U.S. 1101 (1994) 19, 21, 22

Bleistein v. Donaldson Lithographing Co., 188 U.S. 239, 23 S. Ct. 298 (1903) 12, 13, 22

CCC Information Services, Inc. v. Maclean Hunter Market Reports, Inc., 44 F.3d 61 (2d Cir. 1994), *cert. denied*, 516 U.S. 817 (1995) 17-19, 21

C.I.R. v. Duberstein, 363 U.S. 278, 80 S. Ct. 1190 (1960) 28

CMM Cable Rep, Inc. v. Ocean Coast Properties, Inc., 97 F.3d 1504 (1st Cir. 1996) 28

Feist Publications, Inc. v. Rural Telephone Service Co., 499 U.S. 340, 111 S. Ct. 1282 (1991) ..... *passim*

Cited Authorities

Page

Gracen v. The Bradford Exchange, 698 F.2d 300 (7th Cir. 1983) 24, 25

Key Publications, Inc. v. Chinatown Today Publishing Enterprises, Inc., 945 F.2d 509 (2d Cir. 1991) . 18, 19, 21

Kregos v. Associated Press, 937 F.2d 700 (2d Cir. 1991) 19

L. Batlin & Son, Inc. v. Snyder, 536 F.2d 486 (2d Cir.), *cert. denied*, 429 U.S. 857 (1976) 25

Los Angeles News Serv. v. Tullo, 973 F.2d 791 (9th Cir. 1992) 28

Maljack Productions, Inc. v. UAV Corp., 964 F. Supp. 1416 (C.D. Cal. 1997), *aff'd sub nom. Batjac Productions Inc. v. Goodtimes Home Video Corp.*, 160 F.3d 1223 (9th Cir. 1998) 24

Mason v. Montgomery Data, Inc., 967 F.2d 135 (5th Cir. 1992) 20

Moore Publishing, Inc. v. Big Sky Marketing, Inc., 756 F. Supp. 1371 (D. Idaho 1990) 25

Sassafras Enterprises, Inc. v. Roshco, Inc., 889 F. Supp. 343 (N.D. Ill. 1995) 20

Sherry Mfg. Co. v. Towel King of Florida, Inc., 753 F.2d 1565 (11th Cir. 1985) 25

Cited Authorities

	Page
United States v. General Motors Corp., 384 U.S. 127, 86 S. Ct. 1321 (1966)	28
Victor Lalli Enterprises, Inc. v. Big Red Apple, Inc., 936 F.2d 671 (2d Cir. 1991)	19
Warren Pub., Inc. v. Microdos Data Corp., 115 F.3d 1509 (11th Cir.), *cert. denied*, 118 S. Ct. 397 (1997)	20-22
Weissmann v. Freeman, 868 F.2d 1313 (2d Cir.), *cert. denied*, 493 U.S. 883 (1989)	24
Woods v. Bourne Co., 60 F.3d 978 (2d Cir. 1995)	25
Statutes:	
17 U.S.C. § 101	2, 5, 26
17 U.S.C. § 102	2
17 U.S.C. § 103	3, 12
17 U.S.C. § 106	3
17 U.S.C. § 501	3
28 U.S.C. § 1254(1)	1
28 U.S.C. § 1291	1

Cited Authorities

	Page
28 U.S.C. § 1331	1
28 U.S.C. § 1338(a)	1
28 U.S.C. § 2201	1
United States Constitution:	
Article I, section 8, clause 8	1
Rule:	
United States Supreme Court Rule 13	1
Legislative History:	
H.R. REP. NO. 94-1476, *reprinted in* 1976 U.S.C.C.A.N. 5659	16
Other Authorities:	
Michael F. Bowman, *The Second Circuit's Analysis Of Derivative Works By Joint Authors: Good Law — Poor Application*, 56 BROOK. L. REV. 551 (1990)	24
Jane C. Ginsburg, *No "Sweat"? Copyright and Other Protection Of Works Of Information After Feist v. Rural Telephone*, 92 COLUM. L. REV. 338 (1992)	16
1 Paul Goldstein, COPYRIGHT (1998)	5, 17

Cited Authorities

Page

Anant S. Narayanan, *Standards Of Protection For Databases In The European Community And The United States: Feist And The Myth Of Creative Originality*, 27 GEO. WASH. J. INT'L. L. & ECON. 457 (1994) 22

Jon Newman, *In Banc Practice in the Second Circuit, 1989-93*, 60 BROOK. L. REV. 491 (1994) 17

Jon Newman, *In Banc Practice in the Second Circuit: The Virtues of Restraint*, 50 BROOK. L. REV. 365 (1984) 17

1 Melville B. Nimmer & David Nimmer, NIMMER ON COPYRIGHT (1998) 21, 24, 25

Susan H. Nycum, *Protection Of Electronic Databases*, 14 No. 8 COMPUTER LAW. 12 (1997) 17

1 William F. Patry, COPYRIGHT LAW AND PRACTICE (1994) 16, 18, 20, 24, 25

Leah Sherry, *Science Based Standards For The Uniform Global Protection Of Intellectual Property: The Case Of Logic Functions Expressions*, 26 CAL. W. INT'L L.J. 335 (1996) 17

Michelle R. Silverstein, *The Copyrightability of Factual Compilations: An Interpretation Of Feist Through Cases Of Maps And Numbers*, 1996 ANN. SURV. AM. L. 147 (1996) 17

Cited Authorities

Page

William S. Strong, *Database Protection After Feist v. Rural Telephone Co.*, 42 J. COPYRIGHT SOC'Y U.S.A. 39 (1994) 16

Russ VerSteeg, *Rethinking Originality*, 34 WM. & MARY L. REV. 801 (1993) 25

Russ VerSteeg, *Sparks in the Tinderbox: Feist, "Creativity," and the Legislative History of the 1976 Copyright Act*, 56 U. PITT. L. REV. 549 (1995) 16

Ethan L. Wood, *Copyrighting the Yellow Pages: Finding Originality in Factual Compilations*, 78 MINN. L. REV. 1319 (1994) 19, 21

10B C.A. Wright, A.R. Miller & M.K. Kane, FEDERAL PRACTICE AND PROCEDURE: CIVIL § 2770 (3d ed. 1998) 27

Ethan R. York, *Warren Publishing, Inc. v. Microdos Data Corp.: Continuing The Stable Uncertainty Of Copyright In Factual Compilations*, 74 NOTRE DAME L. REV. 565 (1999) 17, 20

APPENDIX

Page

Appendix A — Opinion Of The United States Court Of Appeals For The Second Circuit Dated November 3, 1998 And Filed November 4, 1998 ..... 1a

Appendix B — Memorandum Opinion And Order Of The United States District Court For The Southern District Of New York Dated May 19, 1997 ..... 47a

Appendix C — Judgment Of The United States District Court For The Southern District Of New York Dated June 30, 1997 ..... 58a

Appendix D — Order Of The United States Court Of Appeals For The Second Circuit Denying Petition For Rehearing Dated And Filed December 22, 1998 ..... 60a

Appendix E — Judgment Of The United States Court Of Appeals For The Second Circuit Dated November 3, 1998 And Filed November 4, 1998 ..... 62a

West Publishing Company and West Publishing Corporation (collectively, "West") respectfully request that a writ of certiorari be issued to review the opinion and decision of the United States Court of Appeals for the Second Circuit entered in this case.

OPINIONS BELOW

The opinion of the United States District Court for the Southern District of New York (Pet. App. 47a-57a) is reported at 42 U.S.P.Q.2d 1930, 1996 WL 266972 (S.D.N.Y. May 19, 1997). The opinion of the United States Court of Appeals for the Second Circuit (Pet. App. 1a-46a) is reported at 158 F.3d 674. West's petition for rehearing with a suggestion for rehearing *en banc* was denied on December 22, 1998 (Pet. App. 60a-61a).

STATEMENT OF JURISDICTION

This is a declaratory judgment action by HyperLaw, Inc. ("HyperLaw") seeking judgment that it will not infringe West's copyrights in its compilations of case reports by verbatim copying of an unlimited number of the case reports (after redacting West's synopses, headnotes, and key numbers). The district court had jurisdiction under 28 U.S.C. §§ 1331, 1338(a), and 2201. The Court of Appeals had jurisdiction to hear the appeal under 28 U.S.C. § 1291. A timely petition for rehearing with a suggestion for rehearing *en banc* was denied on December 22, 1998, and this petition for a writ of certiorari was filed within 90 days of that date. This Court's jurisdiction is invoked under 28 U.S.C. § 1254(1), and Supreme Court Rule 13.

CONSTITUTIONAL AND STATUTORY PROVISIONS INVOLVED

Article I, section 8, clause 8 of the United States Constitution provides that:

> The Congress shall have Power . . . To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.

Section 101 of the Copyright Act, 17 U.S.C. § 101, provides that:

> "Copies" are material objects, other than phonorecords, in which a work is fixed by any method now known or later developed, and from which the work can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device.
>
> . . .
>
> A "compilation" is a work formed by the collection and assembling of preexisting materials or of data that are selected, coordinated, or arranged in such a way that the resulting work as a whole constitutes a work of authorship.
>
> . . .
>
> A "derivative work" is a work based upon one or more preexisting works, such as a translation, musical arrangement, dramatization, fictionalization, motion picture version, sound recording, art reproduction, abridgment, condensation, or any other form in which a work may be recast, transformed, or adapted. A work consisting of editorial revisions, annotations, elaborations, or other modifications which, as a whole, represent an original work of authorship, is a "derivative work."

Section 102(a) of the Copyright Act, 17 U.S.C. § 102, provides that:

> Copyright protection subsists, in accordance with this title, in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device. . . .

Section 103(a) of the Copyright Act, 17 U.S.C. § 103, provides that:

> The subject matter of copyright as specified by section 102 includes compilations and derivative works. . . .

Section 103(b) of the Copyright Act, 17 U.S.C. § 103, provides that:

> The copyright in a compilation or derivative work extends only to the material contributed by the author of such work, as distinguished from the preexisting material employed in the work, and does not imply any exclusive right in the preexisting material. . . .

Section 106(1) of the Copyright Act, 17 U.S.C. § 106, provides that:

> [T]he owner of copyright under this title has the exclusive rights to do and to authorize any of the following:
>
> > (1) to reproduce the copyrighted work in copies or phonorecords;
> >
> > (2) to prepare derivative works based upon the copyrighted work;
> >
> > (3) to distribute copies or phonorecords of the copyrighted work to the public by sale or other transfer of ownership, or by rental, lease, or lending. . . .

Section 501(a) of the Copyright Act, 17 U.S.C. § 501, provides that:

> Anyone who violates any of the exclusive rights of the copyright owner as provided by sections 106 through 120 . . . is an infringer of the copyright. . . .

STATEMENT OF THE CASE

It is now nearly ten years since this Court's decision in *Feist Publications, Inc. v. Rural Telephone Service Co.*, 499 U.S. 340, 111 S. Ct. 1282 (1991) established a new interpretative framework for the judicial assessment of the copyrightability of compilations and derivative works. This case, in which the Second Circuit has erected unprecedented barriers to copyright protection that do not appear to be authorized by *Feist*, provides an opportunity for the Court to offer much-needed guidance to the lower courts on the application of the *Feist* standards.[1] Confusion as to the proper interpretation of *Feist*, evident throughout the 1990s, has escalated in recent years, and this doctrinal uncertainty now threatens to impede the development of arrangements, compilations, and derivative works by the publishing industry.

Feist eliminated "sweat of the brow" as a basis for extending copyright protection. Finding that the creation of a standard white-pages telephone directory involved no independent choices at all in the selection or arrangement of data, this Court held the directory to be *completely* devoid of "originality" and therefore uncopyrightable. Copyright protection, the Court ruled, should be withheld in those rare instances in which the author's contribution does not reflect even a "modicum of creativity":

> To be sure, the requisite level of creativity is extremely low; even a slight amount will suffice. The vast majority of works make the grade quite easily, as they possess some creative spark, "no matter how crude, humble or obvious" it might be.

499 U.S. at 345, 111 S. Ct. at 1287 (citations omitted).

Feist was an attempt to bring a new coherence to American copyright law by drawing a firm line between mere fact-gathering (unprotectible) and the independent selection, arrangement, or

---

1. In a separate petition, West seeks review of the Second Circuit's ruling, in a companion case, that West's copyrighted, original arrangement of reported cases may be copied with impunity by CD-ROM technology.

coordination of facts (protectible). However, *Feist*'s reference to a "modicum of creativity" in connection with originality has introduced a "wild card" into the analysis of compilations and derivative works.[2] Some judges, pointing to this Court's strong emphasis on the minimal nature of the originality requirement, have limited the application of *Feist* to those cases in which selection and arrangement are so mechanical or inevitable as to require no real judgment. Others, perhaps misled by the reference to "creativity" in *Feist*, have raised the bar to a level unintended by either this Court or Congress. The post-*Feist* case law is not merely "split." It is truly splintered, with strongly divergent decisions among and within the Circuits, and an array of unusually vigorous dissenting opinions in leading cases.

In this case, the Second Circuit, ostensibly building on *Feist*, established thresholds for originality that go far beyond *Feist* and are unprecedented in the history of American copyright law. The majority acknowledged that West makes numerous independent judgments in determining how to adapt judicial opinions into West case reports, characterizing one of these judgments as "undeniably creative." Nonetheless, after subjecting West's editorial judgments to a series of rigorous tests, the majority — over a strong dissent by Judge Sweet — concluded that West's work is not "creative" enough to be protected even from verbatim wholesale copying. The majority also ignored the cumulative originality of West's revisions in each report, whereas the statute expressly bases originality in this context on the author's contributions "as a whole." 17 U.S.C. § 101. Finally, the majority also held that West's case reports lack originality as derivative works because they do not "substantially" alter the substance or flow of the underlying opinions. This barrier to copyright protection, again, far exceeds the "modicum" called for in *Feist*.

---

2. Although the Court's intentions probably fell short of the broad language it employed, Feist's repeated references to creativity as part of the originality standard, and to the standard's constitutional foundation, have unavoidably introduced a wild card into the question of copyright protection for all forms of data collections. . . .

1 Paul Goldstein, COPYRIGHT § 2.2.1 (1998). *See also* discussion at pp. 15-22, *infra*.

Guidance from this Court, which has never directly addressed the originality requirement for derivative works, is needed to bring order out of the chaos that has followed *Feist*. The need for direction on these important federal questions is heightened by the increasing value — in this era of information "overload" — of efforts to make information manageable through selection, arrangement, revision, adaptation, and annotation. Contrary to Congress' intent in providing for the separate copyrightability of both compilations and derivative works, the Second Circuit's decision dangerously underprotects works involving the selection, arrangement, and coordination of facts. Given the Second Circuit's longstanding prominence and influence in the field of copyright, this decision significantly deepens the uncertainty surrounding the interpretation of *Feist* — and, if allowed to stand as precedential authority, will surely provide a strong disincentive for the creation of compilations and derivative works.

A. The Editorial Enhancements at Issue

In this action, Hyperlaw seeks a declaration that it may copy — verbatim — hundreds of thousands of unidentified case reports from thousands of West's volumes in the *Supreme Court Reporter* and *Federal Reporter* series. It is undisputed that copyright protects certain components of the reports. However, Hyperlaw — which bases this declaratory judgment action on an indistinctly described, hypothetical product — asserts that, once West's syllabi, headnotes, and key numbers are redacted, copyright law does not bar the copying, for purposes of resale, of every word of an unlimited number of West case reports.[3]

At trial, the uncontested evidence demonstrated that West's adaptation and organization of public domain judicial opinions ("Opinions") for publication as case reports involves revisions and additions — wholly apart from syllabi, headnotes, and key numbers — based on independent editorial judgments, and that these

3. West has never objected to the copying, even by competitors, of individual case reports. It is only the threat of wholesale copying of reports by a "free-riding" competitor that compels West to assert and defend its entitlement to copyright protection.

judgments are subject to continual reassessment and case-by-case variation.[4] The bulk of West's editorial work falls into the following categories:

(1) *Updating, revision, and expansion of the citations in Opinions, and the addition of citations when none exist in the Opinions.* West decides when to add parallel citations, and which citations to add.[5] West also decides when to delete a citation in an Opinion and substitute a more useful, current, or accurate "alternative citation."[6] When an Opinion refers to a case by name, but provides no citation, West will independently add its own citation — unless the case appears on West's "Popular Name Listing," a subjective list of cases created and periodically updated

---

4. The facts as to West's editorial work are supported by extensive trial testimony and voluminous trial exhibits and were not questioned by the lower courts.

5. For example, West: (i) expands all Supreme Court case citations to include references to *Supreme Court Reporter* and *Lawyer's Edition* as well as *U.S. Reports* — a choice that is different from that of other publishers and contrary to the explicit Bluebook rule; (ii) adds official state court citations, even when the Bluebook directs otherwise; (iii) decides when to add a Westlaw citation to citations to looseleaf, specialized, or electronic reporters, or slip opinions; (iv) decides when to provide both a LEXIS citation *and* a Westlaw citation; (iv) decides when, and how, to add statute parallel citations; and (v) decides when to add early reporter citations when decisions that pre-date West reporters are cited.

6. For example, West sometimes, but not always, decides to replace (i) electronic or periodical citations with more permanent or accessible citations; (ii) citations to slip opinions or unpublished memoranda with more useful citations; (iii) citations to certain publications with citations to sources that are more widely accepted and/or more likely to be permanently available. Also, if an Opinion includes citations that are outdated, West selectively substitutes up-to-date citations under certain circumstances. For example, West will delete a citation indicating that a petition for certiorari has been filed, and will substitute more up-to-date information, but only if the petition had been acted upon as of the day of the opinion.

by West's editors.[7] As the notes to this paragraph indicate, many of these editorial judgments are substantive and subjective in character, reflecting West's evaluation of its readers' needs and of the relative usefulness — at any point in time — of various citation sources. *See* 158 F.3d at 685 and 691, Pet. App. 25a-30a and 41a.

(2) *The addition of new material, created and/or compiled by West, reflecting subsequent case developments.* When a post-decision order is issued, West independently decides whether, and how, to revise the case report and/or the Opinion to reflect the new development. Depending on the importance of the subsequent development, West may: (i) not report the order at all; (ii) report the subsequent action only in a "file line" written by a West editor who has evaluated the new order; (iii) report the subsequent action only in a table listing; (iv) incorporate the order into the Opinion to create a "combine" in one of several ways, and also create an appropriate file line;[8] (v) publish the order separately and add a cross-reference to an earlier published report; or (vi) completely republish an earlier published report, with appropriate revisions and additions, to reflect the subsequent development.[9] *See* 158 F.3d at 684, Pet. App. 22a-23a.

---

7. West also revises case names in citations to conform them with West's case-titling and corrects any errors or omissions in citations (generally without court involvement, pursuant to West's independent editorial direction). When an Opinion cites a case or statute for a specific rule or fact but does not provide a textual location, West's attorney editors expand these "partial citations," on a case-by-case basis, reading both the Opinion and the cited source to determine whether a specific page reference can, and should, be added.

8. With amending orders, for example, West decides whether: (i) merely to make the changes indicated in the order; or (ii) to incorporate the changes and also publish, following the modified opinion, the order itself (which may include explanatory material and/or a dissenting view), in whole or part.

9. These decisions are based on West's evaluation of the importance of a subsequent order and the potential for confusion. (For example, has the prior opinion been in circulation so long that republication is needed

(Cont'd)

(3) *The addition to Opinions — tens of thousands of which contain no information about attorneys — of attorney-related data selected and compiled by West.* For *Supreme Court Reporter*, West adds to the Opinions, which contain no attorney data, by providing summaries of: (i) the names of arguing counsel (but no other attorneys); and (ii) the city and state of practice (but no other data) for each attorney. Many other publishers of Supreme Court decisions include no attorney data. When other Supreme Court case reports do include attorney data, the publishers — *e.g.*, U. S. Law Week and Florida Law Weekly Federal — make editorial choices entirely different from West's, and from each other. For *Federal Reporter*, West creates summaries of attorney data when the Opinions do not contain any data, and it revises and expands the attorney information that is contained in Opinions from some Circuits.[10] *See* 158 F.3d at 683-84, Pet. App. 20a-21a.

(4) *Revision, editing, and reorganization of the procedural data in Opinions to render them more readable and useful.* West edits the courts' captions for readability and concision, and many captions — generally, those that are long or complex, or both — undergo extensive abridgement, revision, and reorganization. West also revises and rearranges the wording and placement of "court lines" and "date lines" to conform them to West's chosen expression.[11]

(Cont'd)

to avoid confusion?) Decisions as to when, where, and how the material in the subsequent order should be expressed are made solely by West, and do not depend on whether, and how, the court itself decides to republish the opinion.

10. In general, West selects the following data — not the same selection chosen for *Supreme Court Reporter* — for *Federal Reporter* summaries: (a) names of briefing, as well as arguing, attorneys; (b) specification of each attorney's role; and (c) cities of practice (but no address or telephone data), law firm affiliations, and agency titles.

11. When captions involve duplication of parties or multiple actions, West reorganizes the data to create what it believes to be a more useful caption. West also uniformly includes both argument and decision dates,

(Cont'd)

B. The District Court's Decision

The district court issued a sweeping declaratory judgment that West's work in annotating, revising, and adapting the Opinions at issue represents, in all cases, an insufficient "creative effort" to warrant copyright protection. 42 U.S.P.Q. 2d at 1932, Pet. App. 48a. The court based this judgment on findings, *inter alia*, that West's editorial "options are limited" and that "the selections made tend to conform to the standard of the legal profession. . . ." *Id.* at 1934, Pet. App. 54a, 55a.

At the same time, however, the district court described West's addition of parallel citations and replacement of court citations with alternative citations as the "most significant additions West makes to the opinions . . . ." 42 U.S.P.Q. 2d at 1934, Pet. App. 55a. Furthermore, the court acknowledged that in at least some instances West's decisions are *not* "mechanical" and involve "a judgment as to which of a number of equally accessible sources should be cited."[12] Similarly, with respect to West's selective addition of "file lines," the court confined its finding of insufficient originality to "most instances." *Id.* at 1933, Pet. App. 53a. Also, the court acknowledged, with respect to the summaries of attorney data that West creates or revises, that "West clearly makes an editorial judgment as to which attorneys' names to publish and whether to add the city of practice . . . ." *Id.* at 1934, Pet. App. 54a.[13]

(Cont'd)
adding missing information and revising the data in Opinions to conform to West's choices of expression. For example, some courts use "filed" to indicate the decision date; West changes this, since some readers might read "filed" to mean the appeal's filing date.

12. *See* 42 U.S.P.Q. 2d at 1934, Pet. App. 55a (choice of parallel citations is "basically mechanical" in "most instances").

13. The district court's application of a higher standard than the *Feist* standard was at least partially attributable to the court's mistaken impression that copyright protection for the original material in West's reports raises special "policy considerations": "[I]t seems unfair to say that West can preclude anyone from copying what is basically a government document." 42 U.S.P.Q. 2d at 1932, Pet. App. 49a. In fact, the public's

(Cont'd)

C. The Court of Appeals' Decision

The Court of Appeals' majority opinion affirmed the district court's finding that there is no protection, even from verbatim copying, for any of West's work in transforming Opinions into West's *Supreme Court Reporter* and *Federal Reporter* case reports. In assessing the "originality" of West's work, the majority acknowledged *Feist* as the primary authority but imposed a high-threshold, multi-part originality standard. The majority also set forth an unprecedented originality test for derivative works, requiring "substantial" alteration of the "substance and flow" of the underlying public domain work. 158 F.3d at 689, Pet. App. 37a. Judge Sweet's dissent noted that the standards imposed by the majority demand "significantly more" and "far more" than required by *Feist* and other precedents. *Id.* at 690, Pet. App. 38a.

REASONS FOR GRANTING THE WRIT

I.

THE PETITION SHOULD BE GRANTED BECAUSE THE SECOND CIRCUIT HAS ERECTED UNPRECEDENTED BARRIERS TO COPYRIGHT PROTECTION THAT CONFLICT WITH THE *FEIST* STANDARD

The majority did *not* hold that West exercises no independent judgments, or makes the same choices made by virtually all other publishers, or makes only "mechanical" choices. No such finding is conceivable, given the undisputed evidence that: (i) West's case reports differ in substantive ways from public domain opinions and reports of other publishers; and (ii) the expression in West's case reports is the result of dozens of independent, often subjective editorial choices. As Judge Sweet emphasized throughout his

(Cont'd)
unfettered access to public domain opinions is beyond dispute, particularly since the advent of the Internet. There is, in any event, no statutory basis for a different originality standard for works based on government documents. (Tellingly, the district court mischaracterized West's compilations as "the official reports" in an earlier proceeding in this case. 41 U.S.P.Q. 2d 1321, 1330.)

dissent, West's editorial additions and revisions in the case reports at issue involve "substantive, editorial choices" that "express thought and are not inevitable." 158 F.3d at 691, Pet. App. 41a.

Instead, the majority subjected West's editorial judgments to a series of tests that are inconsistent with *Feist* and undermine Congress' longstanding decision to extend copyright protection to compilations and derivative works. 17 U.S.C. § 103. According to the majority, independent choices are insufficiently "original" unless they: (i) involve *more than three* options; *and* (ii) are "non-obvious."[14] Each of these tests imposes a more demanding standard than that prescribed by this Court in *Feist*. To require that editorial choices meet *both* tests is to erect a high hurdle — one that is a complete barrier to even extremely thin copyright protection — that is dramatically at odds with *Feist*'s "extremely low" threshold. Indeed, the majority's multi-part test invites violation of this Court's longstanding ruling, in *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251, 23 S. Ct. 298, 300 (1903), that neither the courts nor the Copyright Office are to judge the quality of a work's originality.

The requirement that editorial choices be "non-obvious" and not "typical"[15] ignores *Feist*'s explicit suggestion that "obvious" or "humble" expressions of independent judgment will satisfy the originality requirement. Applying this high-threshold test, the majority erroneously negated the originality of West's expression that results from decisions that are simply: (i) consistent with general principles of legal reference (but undeniably subjective in their particulars); or (ii) logically responsive to the preferences, as evaluated by West, of its readers.[16]

---

14. *See, e.g.*, 158 F.3d at 682, Pet. App. 17a (requiring "non-obvious choices from among more than a few options" and stating, "[s]election from among two or three options" is "insufficient").

15. One indicator of the majority's ratcheting up of the protection threshold is its consistent use of the term "typical," rather than *Feist*'s language, "entirely typical." *See, e.g.*, 158 F.3d at 677, 685, 687, 688, Pet. App. 26a, 31a, 32a.

16. The majority certainly did not suggest that other publishers make the same citation-revision choices as West. Nor did the court find that the (Cont'd)

Moreover, the majority clearly engaged in the kind of qualitative appraisal barred by *Bleistein* when it found insufficient originality merely because two particular judges shared West's opinion of what constitutes the best editorial choice. For example, the majority found West's selective updating of citations devoid of originality because "West's decision to insert a citation to the denial of certiorari only when the denial pre-dated the opinion is necessary to avoid anachronism. . . ." 158 F.3d at 686, Pet. App. 29a. In fact, of course, the decision is only "necessary" if one shares the highly subjective opinion that it is more important to avoid anachronism than to provide the most up-to-date information — *i.e.*, whether a case cited in an opinion has been granted or denied certiorari. Moreover, other publishers provide no updating at all, a third option that is also completely viable. Nothing "dictates" West's choice among these options; the choice is clearly anything but "inevitable."[17]

In sum, the majority, misreading *Feist*, assumed that it could negate West's originality even though West's reports contain expression resulting from subjective editorial judgments.[18] It is plain

---

(Cont'd)
Bluebook prescribes West's revision choices. At most, the majority merely found that a few of West's choices seem somewhat common or familiar. As the dissent noted, this impression may well be the result of West's longtime success and the familiarity of its works to legal researchers — neither of which is a basis for eviscerating copyright protection. 158 F.3d at 692-93, Pet. App. 45a-46a.

17. The majority conceded that West's subjective decision to allow informal references (without full citation) to certain "popular" cases is an "undeniably creative" practice but negates this originality as well by speculating that any copying of these references would "seem[] to be de minimis. . . ." 158 F.3d at 674 n.10, Pet. App. 30a-31a n.10. This, of course, ignores the systematic character and cumulative effective of the taking.

18. For example, West subjectively evaluates 30 publications as being either: (i) not useful enough to be retained if a West Reporter citation can be substituted; or (ii) so useful that they are always retained, even if a West Reporter citation is available. The majority acknowledged that some *but not all* of the citations replaced by West are from daily or weekly journals. The majority suggested no reason, other than highly subjective evaluation, why West would delete certain permanent-book citations and not delete others. 158 F.3d at 674 n.8, Pet. App. 26a-28a n.8.

— and the majority did not find otherwise — that West could make dozens of different choices, in preparing a single case report for publication, without departing from some "industry standard," breaking the law, or even looking foolish, leading to entirely different expressive content. As Judge Sweet concluded:

> West makes dozens of multi-part, variable judgments, and there is no evidence that any of West's choices are commonplace, "practically inevitable," dictated by law, or that they follow any external guidelines. On the contrary, the record demonstrates that West makes a number of substantive, editorial choices — without court direction or approval — in determining the content and expression of its case reports. West's judgments involve assessments of "readability," clarity, completeness, availability (present and future) of sources, and other subjective considerations related to making the reports more useful.

158 F.3d at 691, Pet. App. 41a. Yet the majority took the position that *Feist* authorizes judicial denial of copyright protection when the court finds some but not enough originality to satisfy its own subjective standard.[19]

---

19. The majority also denied copyright protection because "a competitor would have difficulty creating a useful case report without using many of the same citations." 158 F.3d at 688, Pet. App. 32a. There is no support in the record for this conclusion; as the dissent noted, opinions can, and are, published "with a variety of citation combinations and other facts either included or not." *Id.* at 692, Pet. App. 45a. Moreover, the majority's view represents a *de facto* misapplication of the merger doctrine and a serious misapprehension of the idea/expression dichotomy. West does not secure a monopoly in any ideas by protecting the highly specific, subjectively determined expression in West's case reports. In any event, this case concerns only the verbatim copying of West's case reports, through computer scanning. "The copyright granted West is thin, but it is sufficient to protect against the verbatim digital copying proposed by Hyperlaw. . . ." *Id.* Indeed, under *Feist*, the way to prevent the monopolization of factual data is not to erect barriers to copyrightability but to restrict the extent of protection given these works.

The majority also ruled that West's reports, as derivative works, are insufficiently original because West's revisions and additions do not substantially alter the "substance and flow" of the preexisting Opinions. Moreover, the majority asserted that West's various revisions in a single case report are not collectively protectible because the "whole does not disclose or express an overall creative insight or purpose . . . ." 158 F.3d at 688, Pet. App. 33a. These requirements clearly erect a high originality requirement that is inconsistent with *Feist,* which emphasizes that "the requisite level of creativity is extremely low" and that "[t]he vast majority of works make the grade quite easily." *Feist*, 499 U.S. at 345. This standard, which would deny protection to myriad derivative works that leave intact the "substance and flow" of the existing work, clearly conflicts with the statute's intent and purpose, as does the majority's view that the aggregate originality of an editor's contributions (selection, arrangement, revision, annotation, coordination) should be ignored when the court discerns no "overall creative insight or purpose."

II.

THE PETITION SHOULD BE GRANTED BECAUSE JUDICIAL CONFUSION REGARDING *FEIST* HAS LED TO INCONSISTENT TREATMENT OF, AND UNDERPROTECTION FOR, COMPILATIONS AND DERIVATIVE WORKS

The Second Circuit's decision in this case is not a singular aberration. On the contrary, although the majority opinion may go further afield than any other decision in overburdening *Feist*'s originality standard, it reflects the confused and conflicted state of the law on this subject. Indeed, authors of fact-based works have never faced such uncertainty as to whether their efforts will be afforded copyright protection. At this critical moment in the history of data-intensive publishing, the Second Circuit's ruling — which implicates, in fundamental ways, the Copyright Act's originality requirement for both compilations and derivative works — presents the Court with an ideal framework to revisit *Feist* and address the precedential instability presently confronting judges, publishers, and authors.

As one commentator noted soon after the decision in *Feist*:

> In holding the white pages directory not copyrightable, the Court employed terms that evoke the patent law standards for protectibility. The Court's word choice might best be viewed as rhetorical excess; it should not prompt lower courts to infer that to be deemed "original" a compilation must now be novel and nonobvious. Were Feist so interpreted, then the Court would not only have eliminated the more commodious "sweat" standard of protection, it would also have initiated a different dual copyright system, requiring compilations to meet a higher standard of authorship than is imposed on other kinds of works.[20]

In fact, the lower courts have drawn divergent inferences from the Court's language in *Feist*. The opinion in *Feist* does refer to "creativity" — a word that does not appear in the statute, and hardly figures at all in prior copyright jurisprudence.[21] Yet the

---

20. Jane C. Ginsburg, *No "Sweat"? Copyright and Other Protection Of Works Of Information After Feist v. Rural Telephone*, 92 COLUM. L. REV. 338, 343 (1992).

21. *See* William S. Strong, *Database Protection After Feist v. Rural Telephone Co.*, 42 J. COPYRIGHT SOC'Y U.S.A. 39, 43 (1994). Indeed, the Act's legislative history indicates that the drafters "assiduously avoided including 'creativity' as a component of copyrightability." Russ VerSteeg, *Sparks in the Tinderbox: Feist, "Creativity," and the Legislative History of the 1976 Copyright Act*, 56 U. PITT. L. REV. 549, 552 (1995); *see also* 1 William F. Patry, COPYRIGHT LAW AND PRACTICE 145-48 (1994).

> The [statute's] phrase "original works of authorship," which is purposely left undefined, is intended to incorporate without change the standard of originality established by the courts under the present copyright statute. This standard does not include requirements of novelty, ingenuity, or esthetic merit, and there is no intention to enlarge the standard of copyright protection to require them.

H.R. REP. No. 94-1476, at 51, *reprinted in* 1976 U.S.C.C.A.N. 5659, 5664.

opinion repeatedly emphasizes the "minimal" and "extremely low" nature of the originality threshold. The result, as has been widely noted, is judicial confusion as to what a "modicum of creativity" entails; and whether, or how, to apply *Feist* to works that demonstrate more originality than a white-pages telephone directory.[22]

Most strikingly, the "Eleventh Circuit and the Second Circuit have split in their interpretation of Feist."[23] In all post-*Feist* cases except this one, the Second Circuit has applied *Feist* cautiously, keeping in mind its particular facts, the Court's explicit emphasis on the "minimal" originality requirement, and the fundamental purpose of the statute.[24] In *CCC Information Services, Inc. v.*

22. *See, e.g.*, Michelle R. Silverstein, *The Copyrightability of Factual Compilations: An Interpretation Of Feist Through Cases Of Maps And Numbers*, 1996 ANN. SURV. AM. L. 147, 161-62 (1996) ("While the Court was specific about what must be evaluated for a compilation copyright, just how much creativity is needed or exactly what qualifies as 'creative' was never made sufficiently clear. . . . Because of this lack of specificity regarding the meaning of creativity, subsequent courts have been uncertain as to how to apply the Supreme Court's ruling."); Leah Sherry, *Science Based Standards For The Uniform Global Protection Of Intellectual Property: The Case Of Logic Functions Expressions*, 26 CAL. W. INT'L L.J. 335, 342 (1996) (" 'Confusion' is the best description of the state of post-Feist copyright protection "); Goldstein, *supra*, at § 2.2.1 (Court "offered few clues as to what it meant by 'creativity,' and, indeed, whether the requirement is quantitative or qualitative.").

23. Susan H. Nycum, *Protection Of Electronic Databases*, 14 No. 8 COMPUTER LAW. 12, 14 (1997); *see also* Ethan R. York, *Warren Publishing, Inc. v. Microdos Data Corp.: Continuing The Stable Uncertainty Of Copyright In Factual Compilations*, 74 NOTRE DAME L. REV. 565, 588 (1999).

24. Despite the split of authority within the Second Circuit created by the decision below, West's petition for a rehearing *en banc* was denied. This denial is consistent with the circuit's longstanding policy of denying virtually all such petitions (only one was granted in all of 1998) and leaving the resolution of important federal questions to this Court. *See* Jon Newman, *In Banc Practice in the Second Circuit, 1989-93*, 60 BROOK. L. REV. 491 (1994); Jon Newman, *In Banc Practice in the Second Circuit: The Virtues of Restraint*, 50 BROOK. L. REV. 365, 383 (1984).

Maclean Hunter Market Reports, Inc., 44 F.3d 61 (2d Cir. 1994), *cert. denied*, 516 U.S. 817 (1995), Judge Leval analyzed *Feist*, emphasizing the dangers of reading the decision as anything more than a rejection of protection based solely on "sweat of the brow." In words equally applicable to this case, he wrote:

> The Court repeatedly stressed that the required level of originality is minimal, and that most compilations, merely by exercising some independent choice in the coordination, selection, or arrangement of data, will pass the test. The telephone directory failed because it was found to be *completely* devoid of originality. . . .
>
> The thrust of the Supreme Court's ruling in *Feist* was not to erect a high barrier of originality requirement. It was rather to specify, rejecting the strain of lower court rulings that sought to base protection on the "sweat of the brow," that *some* originality is essential to protection of authorship, and that the protection afforded extends only to those original elements.[25] Because the protection is so limited, there is no reason under the policies of the copyright law to demand a high degree of originality. To the contrary, such a requirement would be counterproductive. The policy embodied into law is to encourage authors to publish innovations for the common good — not to threaten them with loss of their livelihood if their works of authorship are found insufficiently imaginative.

Id. at 65, 66 (emphasis in original). Judge Leval also warned that originality is not negated by logical choices that respond to the "needs of the market." To the contrary, "the use of logic to solve the problems of how best to present the information being compiled is independent creation." *Id.* at 67.

The other leading post-*Feist* Second Circuit decisions are to the same effect. In *Key Publications, Inc. v. Chinatown Today Publishing Enterprises, Inc.*, 945 F.2d 509 (2d Cir. 1991), the court described

---

25. *See also* Patry, *supra*, at 199-200 ("The key factor is the exercise of *some* editorial judgment in the selection of data.") (emphasis added).

the minimal level of editorial judgment required by *Feist* as "de minimis thought." *Id.* at 514. In *Kregos v. Associated Press*, 937 F.2d 700 (2d Cir. 1991), the court emphasized that *Feist* described the "narrow category" of uncopyrightable works as those in which the " 'selection and arrangement of facts [is] so mechanical or routine as to require no creativity whatsoever.' " *Id.* at 704, *quoting Feist*, 499 U.S. at 362, 111 S. Ct. at 1296.[26]

By contrast, the Eleventh Circuit has taken the position that *Feist* authorizes the denial of copyright protection — based on subjective judicial standards — to expression that is the result of independent editorial judgment. While the Second Circuit extended thin copyright protection to a yellow-pages directory in *Key Publications*, the Eleventh Circuit — in an *en banc* reversal of a circuit panel decision — denied any protection to the yellow-pages directory at issue in *BellSouth Advertising & Publishing Corp. v. Donnelley Information Publishing, Inc.*, 999 F.2d 1436 (11th Cir. 1993) (en banc), *cert. denied*, 510 U.S. 1101 (1994). As one commentator has observed, the "Eleventh Circuit's approach directly contradicts Key Publications."[27] This inconsistency is further demonstrated by the fact that the Eleventh Circuit's first decision in the case — which found the work copyrightable — was cited by other Courts of Appeal as an exemplary application of *Feist*. *See, e.g., Atari Games Corp. v. Oman*, 979 F.2d 242, 246 (D.C. Cir. 1992); *Atari Games Corp. v. Nintendo of Am., Inc.*, 975 F.2d 832, 840 (Fed. Cir. 1992).

---

26. Indeed, prior to this case, the Second Circuit applied *Feist* to deny copyright protection to a textual work only once, and that case, *Victor Lalli Enterprises, Inc. v. Big Red Apple, Inc.*, 936 F.2d 671 (2d Cir. 1991), exemplifies the rare situation in which "the creative spark is so utterly lacking as to be 'virtually nonexistent.' " *CCC*, 44 F.3d at 67, *citing Feist*, 499 U.S. at 359, 111 S. Ct. at 1295. In *Victor Lalli*, the plaintiff chart publisher made no independent selection or arrangement at all, having adopted "the exact same format" as every other publisher with "no opportunity for variation." *Id.* at 672-73.

27. Ethan L. Wood, *Copyrighting the Yellow Pages: Finding Originality in Factual Compilations*, 78 MINN. L. REV. 1319, 1335 (1994).

More recently, in another *en banc* ruling, a majority of the Eleventh Circuit found a directory of cable television systems to be uncopyrightable, despite the fact that the publisher made a selection and arrangement of facts that departed from previous compilations. *Warren Pub., Inc. v. Microdos Data Corp.*, 115 F.3d 1509 (11th Cir.) (en banc), *cert. denied*, 118 S. Ct. 397 (1997). Yet the dissenting judges found *Feist* to be no obstacle to protection: "Warren's selection of data is original, creative and useful. To suggest it is the only conceivable useful way [like the white pages in *Feist*] is astonishing." *Id.* at 1530 (Godbold, J., dissenting). As one commentator states:

> These elements of selection, coordination, and arrangement far exceed the *Feist* minimum threshold of originality. The majority's opinion is as baffling as it is contrary to the law and the facts.

Patry, *supra*, at 18 (1998 Supp.).[28]

Thus, the circuits are not only split but also internally divided.[29] The Eleventh Circuit has long been in "turmoil," with

28. *See also* York, *supra*, 74 NOTRE DAME L. REV. 565, 588: "What makes the Warren decision so perplexing is the way the Eleventh Circuit so heavily relied on Feist in reaching its decision, notwithstanding Feist's contrary proclamations."

29. Similarly, courts of the Seventh Circuit, like the Eleventh (and, now, the Second), have used *Feist* to deny copyrightability to works that almost certainly would be protected by other federal courts. In *Sassafras Enterprises, Inc. v. Roshco, Inc.*, 889 F. Supp. 343, 346-47 (N.D. Ill. 1995), the court found insufficient originality in a 15-page booklet containing recipes and directions for the care of a pizza stone because "the effort was really compelled by the realities of the marketplace," and the "requisite level of skill and discretion" was missing; a "rather surprising" decision, according to one distinguished commentator. Patry, *supra*, at 255 n.588 (1998 Supp.). In sharp contrast are decisions stressing the minimal nature of the *Feist* standard — *e.g.*, *Atari Games Corp. v. Oman*, *supra*, 979 F.2d at 247 (rejecting attempt to "ratchet" up the protection threshold beyond *Feist*'s "minimal creative spark"); *Mason v. Montgomery Data, Inc.*, 967 F.2d 135 (5th Cir. 1992) (sufficient originality because choices "resulted in independent expression").

"blistering" dissents in *BellSouth* and *Warren*.[30] Now the Second Circuit is in turmoil as well. Few readers of *Key Publications* or *CCC* (among the most widely cited post-*Feist* decisions) could anticipate that the same Court of Appeals would issue the rulings in this case. Courts around the country no longer can look to the Second Circuit for a consistent view of *Feist*.

Inevitably, and completely contrary to Congress' statutory intent, this doctrinal uncertainty will discourage the creation of new compilations and derivative works at a time when works of this kind are particularly needed to select, organize, and present vast quantities and types of data now available in electronic formats. Even before the decisions in this case and in *Warren* were issued, commentators warned that confusion as to *Feist*'s parameters constituted a disincentive to the creation of new works. Typical are the following excerpts, both published in 1994:

> The Feist decision . . . has led to different interpretations of copyright protection for . . . factual compilations. Courts have applied inconsistent standards when evaluating copyright protection for yellow pages directories. Clarifying the appropriate standard of protection is important not only to the yellow pages industry . . . but also to other industries that produce factual compilations, particularly the computer database industry.[31]

> At present, the scope of the Feist rule remains unclear. The muddled state of copyright law after Feist regarding the protection afforded databases provides uncertainty as to future challenges to the usurpation of database materials. It especially bodes ill for the emerging world of electronic databases. Because the Supreme Court has

---

30. 1 Melville B. Nimmer & David Nimmer, NIMMER ON COPYRIGHT, § 3.04 n.64 (1998). *See also* Wood, *supra*, 78 MINN. L. REV. at 1344 n.8 ("The history of the BellSouth case provides a good illustration of the confusion that Feist has engendered").

31. Wood, *supra*, 78 MINN. L. REV. at 1320.

> not had an opportunity to revisit the creative originality requirement, it is impossible to state with any degree of certainty the amount of creative originality that would satisfy the requirements of Feist. . . . Hence, the Feist decision will continue to cast its shadow over works that are on the borderline of copyrightability unless the rule is clarified or excised. As a consequence, it is important for the Court to revisit Feist . . . .[32]

Since 1994, as the electronic publishing industry has become increasingly vital to the American economy, the confusion as to protectibility for compilations has become even greater.

Indeed, the Second Circuit's subjective application of a test for "non-obviousness" is inconsistent not only with *Feist* but with this Court's rejection, in *Bleistein*, of any form of an artistic merit test as a regulator of copyright protection. Given that independent creation is not infringement under copyright law (in contrast to patent law), a merit test is unnecessary; it is also difficult to administer and will inevitably deny protection to works that prove valuable. In the American tradition of copyright law, which has served us well, courts are barred from making value judgments about the relative quality or creativity of an author's work.

In this case, and others like it, judges are turning their backs on that tradition and effectively making merit decisions about the copyrightability of works of expression. Thus, these cases raise a public policy question of enormous proportion under the Copyright Act, and only this Court can eliminate the confusion.[33]

---

32. Anant S. Narayanan, *Standards Of Protection For Databases In The European Community And The United States: Feist And The Myth Of Creative Originality*, 27 GEO. WASH. J. INT'L. L. & ECON. 457, 469 (1994).

33. This case, unlike *Warren* and *BellSouth*, involves a wide array of different kinds of editorial contributions and decisions, including, *inter alia*, category selection, choices of data within categories, arrangement and reorganization of data, abridgement, and the creation of original text to report on subsequent case developments. Thus, this Court's analysis of the Court of Appeals' decision would provide unusually valuable guidance to the lower courts.

III.

THE PETITION SHOULD BE GRANTED BECAUSE CONFUSION CONCERNING THE ORIGINALITY STANDARD FOR DERIVATIVE WORKS POSES A SERIOUS DISINCENTIVE TO THE CREATION OF NEW WORKS

The Second Circuit's decision also seriously exacerbates the uncertainty in the lower courts' use of an originality requirement for derivative works — a subject that has never been addressed by this Court. The majority denied derivative work protection to West's adaptations of public domain Opinions because West's contributions do not result in "substantial changes to the substance and flow" of the preexisting works. 158 F.3d at 689, Pet. App. 37a.[34] This unprecedented standard is inconsistent not only with *Feist* but also with the longstanding originality test for derivative works enunciated by the Second Circuit itself and adopted by many courts:

> [A] "copy of something in the public domain" will support a copyright if it is a "distinguishable variation". . . . All that is needed to satisfy both the Constitution and the statute is that the "author" contributed something more than a "merely trivial" variation, something recognizably "his own." Originality in this context "means little more than a prohibition of actual copying." No matter how poor artistically the author's addition, it is enough if it be his own.

---

34. Both the majority and dissent found that West's case reports have certain characteristics of compilations and derivative works, and that the originality requirement in either case is "essentially the same" and governed by *Feist*. 158 F.3d at 680 and 690, Pet. App. 11a and 39a. In creating its case reports, West acts as a compiler, choosing, for example: (i) the selection and arrangement of the case-report elements; (ii) which citations to include in the opinions; and (iii) what attorney-related data to include, and how to arrange and express it. At the same time, West acts as a derivative work author — updating, revising, annotating, and adding new elements to judicial opinions.

Alfred Bell & Co. v. Catalda Fine Arts, Inc., 191 F.2d 99, 102-03 (2d Cir. 1951) (citation and footnotes omitted). The Second Circuit reaffirmed the *Alfred Bell* standard as "the law in this circuit" in *Weissmann v. Freeman*, 868 F.2d 1313, 1321 (2d Cir.), *cert. denied*, 493 U.S. 883 (1989). *See also* Nimmer, *supra*, at § 3.03 (enhancements are protectible if they are "sufficient to render the derivative work distinguishable from its prior work in any meaningful way. . . . ").

The *Alfred Bell* standard — a distinguishable variation that is more than "merely trivial" — plainly imposes no requirement that a derivative work contain "substantial" changes to the "substance and flow" of a preexisting public domain work. However, some courts have adopted a contrary standard that requires changes in a derivative work to be not just non-trivial, but "substantial":

> Two standards have developed within the federal circuits as tests for [derivative work] originality. On one side of the spectrum is the low threshold "distinguishable variation" standard. . . . On the other side of the spectrum is the high threshold "substantial variation" standard used by the Seventh Circuit as expressed in *Gracen v. The Bradford Exchange*, 698 F.2d 300 (7th Cir. 1983).[35]

Gracen has been widely criticized.[36] Some courts have recognized that *Feist*'s "modicum" standard, indisputably applicable to derivative works, effectively overrules any test that requires a "substantial" alteration as a condition for derivative work originality. In *Maljack Productions, Inc. v. UAV Corp.*, 964 F. Supp. 1416, 1426 (C.D. Cal. 1997), *aff'd sub nom. Batjac Productions Inc. v. Goodtimes Home Video Corp.*, 160 F.3d 1223 (9th Cir. 1998), for example, the court held that, in light of *Feist*, "the

---

35. Michael F. Bowman, *The Second Circuit's Analysis Of Derivative Works By Joint Authors: Good Law — Poor Application*, 56 Brook. L. Rev. 551, 564-65 (1990).

36. *See, e.g.*, Patry, *supra*, at 162 (the *Gracen* court "misunderstood the [originality] standard altogether").

contention that a derivative work must contain 'substantial originality' in order to receive statutory copyright is simply wrong."

Nonetheless, before and after *Feist*, the "substantial variation" standard has been applied by numerous courts, many of them relying as well on the Second Circuit's use of the word "substantial" in *L. Batlin & Son, Inc. v. Snyder*, 536 F.2d 486 (2d Cir.), *cert. denied*, 429 U.S. 857 (1976).[37] Yet the facts – and most commentators – suggest that the *Batlin* court was simply applying the minimal *Alfred Bell* standard.[38]

Typically, then, "the Second Circuit has had problems articulating a single standard of originality for derivative works," and the "district courts in the Seventh Circuit . . . are still struggling with the standard of originality for derivative works." Patry, *supra*, at 162 n.170 (1998 Supp.). Thus, the decision in this case further aggravates a pervasive confusion as to whether derivative works

---

37. *See, e.g., Woods v. Bourne Co.*, 60 F.3d 978, 990 (2d Cir. 1995) (citing *Gracen* and *Batlin* and using "substantiality" test to deny copyrightability to a piano-vocal arrangement); *Sherry Mfg. Co. v. Towel King of Florida, Inc.*, 753 F.2d 1565, 1568 (11th Cir. 1985) (invoking "substantial" standard, *citing Batlin*). In *Moore Publishing, Inc. v. Big Sky Marketing, Inc.*, 756 F. Supp. 1371, 1375 (D. Idaho 1990), the court expressed the "confusion" in applying *Gracen* and *Batlin*:

> It would appear that a contribution could be more than trivial, but still not substantially different from the preexisting work. Would such a contribution be entitled to protection? The Court need not answer that question.

38. In *Batlin* a plastic replica of an iron toy bank was held not to meet the standard because the replica merely changed the physical medium of the work; it was "practically an exact copy and [any] differences are so infinitesimal they make no difference." 536 F.2d at 489. *See, e.g.*, Nimmer, *supra*, at § 3.03 n.6 ("Batlin did not suggest a new test for derivative work originality. On the contrary, it relied heavily on the teachings of *Alfred Bell*. . . ."); Russ VerSteeg, *Rethinking Originality*, 34 Wm. & Mary L. Rev. 801, 883, n.17 (1993) ("Quite obviously . . . the court in *Batlin* used the term 'substantial variation' merely to delineate a point just above 'trivial,' and not, as Judge Posner suggested in *Gracen*, to forge a new level of variation that was copyrightable").

that contain non-trivial, distinguishable variations are copyrightable. Certainly no prior court has gone so far as to demand that a textual derivative work, adapted from public domain material, is entitled to no copyright protection whatsoever unless it offers "substantial" changes to the "substance and flow" of the underlying work. This fundamental misconstruction of the originality requirement cannot be reconciled with the express statutory provision that derivative works may consist of "editorial revisions, annotations, elaborations, or other modifications . . . ." 17 U.S.C. § 101. Indeed, the Second Circuit's version of the "substantial variation" standard would deny protection to original annotations and cross-references in a newly published edition of Shakespeare's plays; such non-trivial variations do not alter the "substance and flow" of the underlying work in any way, let alone substantially. Similarly, the Second Circuit's standard would deny protection to non-trivial revisions and additions that update an existing work yet leave its "substance and flow" intact.

Clearly, during the past decade, the general principles enunciated in *Feist* have provided insufficient guidance on this issue for the lower courts, whose opinions conflict with each other and with *Feist*. Congress' decision to protect derivative works has now been thrown into even greater doubt by the decision below, which raises serious questions about the copyrightability of works — including annotated versions, revisions, and adaptations — that are critical to every field of learning and every form of expression. Absent review by this Court, the threat of significant underprotection for textual derivative works — precisely the kind of works needed to deal with the dissemination of unannotated and disorganized data of all kinds through new technologies — will discourage the creation of new works in this field. Clarification of this important federal question would benefit all those authors, publishers, and users — from database manufacturers to editors of scholarly editions — who work with facts or who try to give new life and utility to public domain material.

IV.

THE PETITION SHOULD BE GRANTED BECAUSE THE SECOND CIRCUIT DEPARTED FROM LONGSTANDING PRINCIPLES AS TO THE BURDEN OF PROOF IN DECLARATORY JUDGMENT ACTIONS

The order below permits verbatim copying of tens of thousands of unspecified, individual *Supreme Court Reporter* and *Federal Reporter* case reports. The finding that none of these reports could contain protectible expression is based on impermissible speculation and an improper allocation of the burden of proof. HyperLaw never attempted to offer — and the decisions below do not refer to — any purported analysis of West's work based on a review of a representative, statistically significant sampling of the reports. For example, HyperLaw limited its evidence regarding *Federal Reporter* to a partial one-volume sampling reflecting West's adaptation of opinions from only three of the thirteen circuits despite the undisputed fact that West's work varies from circuit to circuit. Moreover, HyperLaw never specified which, or how many, case-reports it intended to copy.

The record below could not even theoretically support a finding that strips West of protection for all *Supreme Court Reporter* and *Federal Reporter* reports. This Court's guidance is needed because the Second Circuit's affirmance of this speculative and sweeping declaratory judgment throws into question the well-settled principle that the party seeking relief bears the burden of proof in declaratory actions. *See, e.g.*, 10B C.A. Wright, A.R. Miller & M.K. Kane, FEDERAL PRACTICE AND PROCEDURE: CIVIL § 2770 (3d ed. 1998).

V.

THE PETITION SHOULD BE GRANTED SO THAT THIS COURT CAN ADDRESS JUDICIAL DIVISION AS TO THE PROPER STANDARD OF REVIEW IN CASES INVOLVING COPYRIGHT ORIGINALITY

The Second Circuit's ruling that findings as to copyright originality always are reviewed for clear error (158 F.3d at 681,

Pet. App. 12a-13a) conflicts with principles enunicated by this Court and with the rule in other circuits. This Court has enunicated the general principle that the proper standard of review for an application of law to fact is *de novo* unless the inquiry is founded on the lower court's "experience with the mainsprings of human conduct" (*e.g.*, questions of intent or reasonableness). *C.I.R. v. Duberstein*, 363 U.S. 278, 289, 80 S. Ct. 1190, 1198 (1960). Application of the Copyright Act's originality standard to undisputed facts is, by contrast, an inquiry focused on judgment about the values that animate legal principles. *Cf. United States v. General Motors Corp.*, 384 U.S. 127, 141, n.16, 86 S. Ct. 1321, 1328, n.16 (1966) ("the question here is not one of 'fact,' but rather of the legal standard required to be applied to the undisputed facts").

As the First Circuit recently noted, *Feist* — deciding originality as a matter of law — makes it clear that originality is essentially a legal inquiry when the facts are undisputed. *CMM Cable Rep, Inc. v. Ocean Coast Properties, Inc.*, 97 F.3d 1504, 1417 (1st Cir. 1996). *See also Los Angeles News Serv. v. Tullo*, 973 F.2d 791, 793 (9th Cir. 1992) ("Whether the raw tapes are sufficiently original to merit copyright protection is a mixed question of law and fact that we examine de novo."). Yet the Second Circuit and other circuits apply a contrary rule, and only this Court can resolve this fundamental inconsistency and confusion in the administration of the Copyright Act.

CONCLUSION

For the foregoing reasons, it is respectfully submitted that this petition should be granted.

Respectfully submitted,

JAMES F. RITTINGER
Counsel of Record
JOSHUA M. RUBINS
SATTERLEE STEPHENS BURKE
& BURKE LLP
230 Park Avenue
New York, New York 10169
(212) 818-9200

ARTHUR R. MILLER
228 Areeda Hall
1545 Massachusetts Avenue
Cambridge, Massachusetts 02138
(617) 495-4111

Attorneys for Petitioners